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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,229	01/29/2002	Peter Herold	2001-1907A	3386
513	7590	01/28/2005	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			REYES, HECTOR M	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1625	

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/048,229

**Applicant(s)**

HEROLD ET AL.

**Examiner**

Hector M Reyes

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION****Status of The Claims**

Claims 1-9 have been amended. Claims 10-18 have been withdrawn from consideration. Currently, claims 1-9 are under Examination.

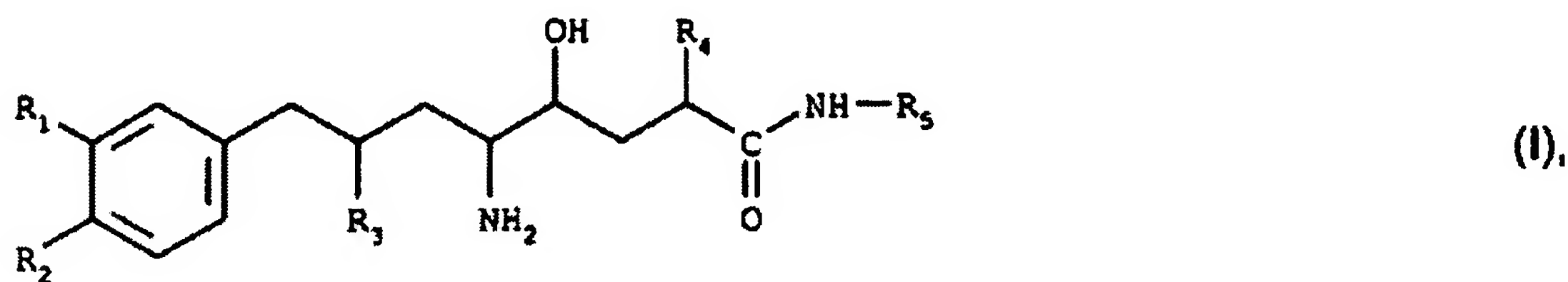
**Restriction Requirement**

Regarding the lack of unity/restriction requirement, Applicant argues that there is a special technical feature among all the outlined groups previously presented. However, the said restriction has been made final in the previous office action dated on 7/28/2004.

Contrary to Applicant's opinion, there is no unity of invention linking the outlined Groups because the inventions listed as Groups I through IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

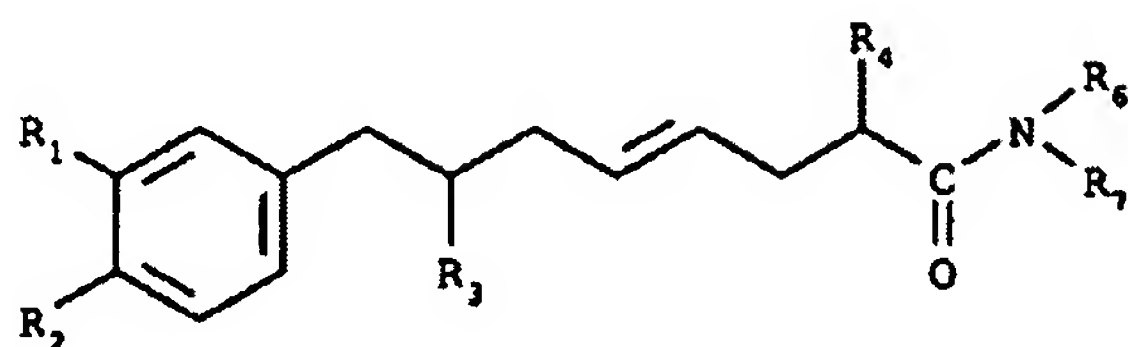
Compounds claimed in Groups I, II, III and IV contain significantly different chemical structures and do not share a common core:

Group I



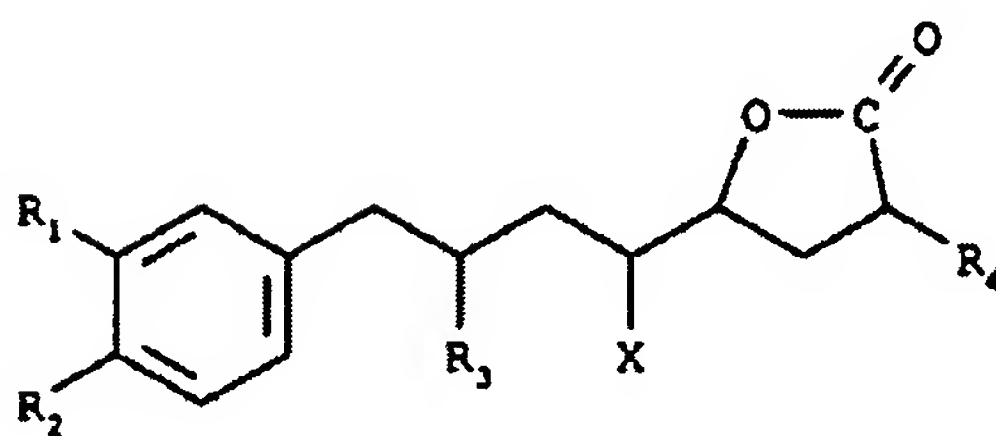
Group II

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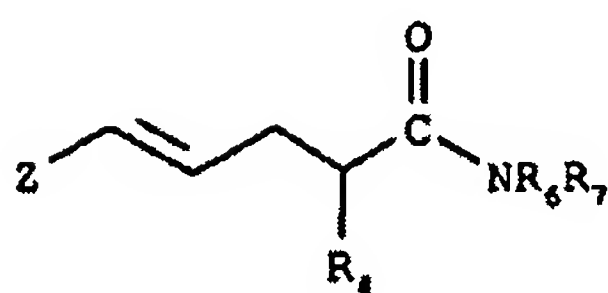
(II),

Group III



(III),

Group IV



(VII),

Clearly each one of the above structures do not share a common core, thus there is No special technical feature linking each one of the groups. Group I, is ***drawn to a process for the preparation of compounds of formula I***, which does not necessarily required any of the claimed compounds in claimed in Groups II, III or IV for its preparation.

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Moreover, compounds claimed in Groups II, III and IV can be used in multiple other syntheses not related to the process claimed in Group I.

Indeed a given references anticipating or suggesting any of the compounds claimed in Groups II, III or IV cannot be used to reject any of the claims of Group I under 35 USC 102 or 35 USC 103.

The requirement is still deemed proper and is therefore made FINAL.

### **Objections Withdrawn**

Objection to the specification are hereby withdraw in view of Applicant's response and remarks. Objection to claims 2-7 and 9 are withdrawn in view of Applicant's 1, 8 and 9.

### **Rejections Withdrawn**

#### ***Claim Rejections - 35 USC § 112***

Rejection claims 1-2 and 8 under second paragraph of 35 U.S.C. 112 are withdrawn in view of Applicant's amendment and Remarks.

### **Allowable Subject Matter**

No prior art disclosing or suggesting the instant invention was found. The closest art relevant to the instant invention was found in Herold et al, Journal Organic Chemistry, 54 (5), pages 1178-1185 (1989). The said reference has been acknowledges by Applicants in page 10 of the instant specification.

Herold, one of the instant inventors, teaches a method for the preparation of hydroxyethylene dipeptide isosteres. However, the said derivatives are not embraced by formula I of the instant claims and they only have three chiral

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centers, while the instant target contains four, thus it would not be obvious to predict the behavior of the additional substituent in the known synthetic pathway as well as the stereocontrol described in claim 8.

### **CONCLUSION**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes, PhD JD whose telephone number is (571) 272-0691. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rita Desai can be reached on (571) 272-0684. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is

703-308-1235.

Hector M. Reyes PhD JD  
Reg. # P-54,846  
AU 1625  
January 27, 2005.

Ms. Rita Desai  
Primary Examiner

*R. Desai*

*1/27/05.*